

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR M. BOLZE, JONATHAN W. BROWN,
ANDREW L. KURKJIAN, TIMOTHY L. LONG, ANGUS J. MELBOURNE,
LINWARD A. MOORE, and ROBERT P. ZIMMERMAN

Appeal No. 2003-0533
Application No. 09/511,183

HEARD: JUNE 11, 2003

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 8, 10, 11, and 13 through 31. Claim 9 stands objected to as being dependent upon a rejected base claim, while claim 12 has been allowed. These claims constitute all of the claims in the application.

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Appellants' disclosed invention pertains to a sample module for use in a downhole tool to obtain fluid from a subsurface formation penetrated by a wellbore, to an apparatus for obtaining fluid from a subsurface formation penetrated by a wellbore, and to a method for obtaining fluid from a subsurface formation penetrated by a wellbore. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 13, and 22, respective copies of which appear in the APPENDIX to the main brief (Paper No. 24).

As evidence of obviousness, the examiner has applied the documents listed below:

Ringgenberg	4,633,952	Jan. 6, 1987
White et al (White)	4,856,585	Aug. 15, 1989
Dave et al (Dave)	5,269,180	Dec. 14, 1993
Michaels et al (Michaels) ¹	5,377,755	Jan. 3, 1995
Massie et al (Massie)	5,609,205	Mar. 11, 1997
Hrametz et al (Hrametz)	5,934,374	Aug. 10, 1999

¹ We have focused upon the listed Michaels document, which is a Continuation-in-part of Michaels et al (U.S. Patent No. 5,303,775), referenced by appellant in footnote #1 of the reply brief (Paper No. 26).

The following rejections are before us for review.

1. Claims 1, 2, 4 through 6, 8, 10, 22, 23, 25, 26 through 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Michaels in view of White.
2. Claims 3 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Michaels in view of White, as applied to claims 1 and 22 above, further in view of Dave.
3. Claims 7 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Michaels in view of White, as applied to claims 1, 6, and 10 above, further in view of Ringgenberg.
4. Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Michaels in view of White and Dave, as applied to claims 22, 25, 27, and 28 above, further in view of Hrametz.
5. Claim 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Michaels in view of White and Dave, as applied to claims 22, 25, 27, and 30 above, further in view of Massie.

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6. Claims 13 through 17, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Michaels in view of White and Dave.

7. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Michaels in view of White and Dave, as applied to claims 13 through 17 above, further in view of Hrametz.

8. Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Michael in view of White and Dave, as applied to claims 13 through 16, and 19 above, further in view of Massie.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 25), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 24 and 26).

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied teachings,² and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We do not sustain any of the examiner's eight rejections of appellants' claims under 35 U.S.C. § 103(a).

Initially, we recognize that an object of appellant's invention (specification, page 3) is to provide

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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an independent validation sample chamber, having a substantially smaller capacity than the sample chamber, that will be safer and easier to heat and recombine separated sample components on the surface for validating the quality of the sample at the well site.

Independent claim 1 is drawn to a sample module for use in a downhole tool to obtain fluid from a subsurface formation penetrated by a wellbore, comprising, inter alia, a sample chamber carried by the module, a validation chamber carried by the module, with the validation chamber being smaller than the same chamber and independently removable from the sample module.

Independent claim 13 sets forth an apparatus for obtaining fluid from a subsurface formation penetrated by a wellbore, comprising, inter alia, a probe assembly, a pump assembly, a sample chamber, and a validation chamber smaller than the sample chamber and independently removable from the apparatus.

Independent claim 22 addresses a method for obtaining fluid from a subsurface formation penetrated by a wellbore, comprising, inter alia, delivering a sample of formation fluid moved into an apparatus to a sample chamber for collection therein, delivering a representative sample of formation fluid to a validation

chamber for collection therein, the validation chamber being smaller than the sample chamber, removing the validation chamber from the apparatus without disturbing the sample chamber, and evaluating the representative sample whereby the viability of the sample in the sample chamber is determined.

In rejecting each of these independent claims, the examiner has relied upon at least the basic combination of the Michaels and White patents.

A review of the Michaels reference reveals to us the knowledge in the subsurface formation testing art of an apparatus including removably assembled sample vessels that can be transported separately to a suitable site for laboratory analysis or analyzed on site (column 1, lines 14 through 26 and column 5, line 59 to column 6, line 5). Sample container receptacles or tanks 26, 28 (Fig. 2) are perceived as being of the same size.

The patent to White addresses (column 5, lines 57 through 68) a sample apparatus for use in a well that includes four removable sample chambers 104, 106, 108, and 110 (Figs. 2C-2E and Fig. 3). As indicated by the patentee, (column 10, lines 46

through 50) the chambers are relatively small as compared to those utilized in prior art tubing conveyed pressure actuated samplers.

When we set aside in our minds that which appellants have taught us in the present application and focus upon the collective teachings of Michaels and White, it at once becomes apparent to us that the reference teachings would not have been suggestive of the now claimed sample module, apparatus, and method to one having ordinary skill in the art. At best, Michaels and White may be viewed as teaching the alternatives of using all larger or all relatively smaller sample vessels. From our perspective, only by relying upon impermissible hindsight and appellants' own teaching would one having ordinary skill have been able to derive the claimed invention from the teachings of Michaels and White. The examiner has also applied the respective patents to Dave, Ringgenberg, Hrametz, and Massie to address features apart from the smaller sizing of a validation chamber relative to a sample chamber. A review of the latter documents reveals to us that they do not overcome the discussed deficiency of the Michaels and White patents. It is for the reasons given above that the rejections before us cannot be sustained.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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